

REMARKS

Claims 1 has been amended to improve the claim language. Claims 3, 4 and 6 have been amended to resolve antecedent basis issues. No new matter has been added. Claims 1-8 remain pending in this application.

Claims 1 and 5 are rejected under 35 USC 102(b) on Niederer (US 4,359,785). Claims 4 and 8 are rejected under 35 USC 103(a) on Niederer. Claims 2, 3, 6 and 7 are rejected under 35 USC 103(a) on Niederer in view of Tanamal (US 5,755,811). These rejections are respectfully traversed.

Claim 1 recites a hip prosthesis having a shaft and a femoral neck. The shaft has a proximal part to be inserted in a metaphyseal region of the femur. The proximal part has fins that project from its front and rear faces. The fins have a steep medial flank. The width of the fins increases from the distal end to the proximal end of the proximal part. Claim 1 has been amended to clarify that each fin has a surface portion delimited by a medial edge and a lateral edge, and that the medial edge forms a borderline between the surface portion and the steep flank. Support for these amendments can be found, for example, in the specification at page 5, lines 25-36. These aspects of the claimed invention are neither taught nor suggested by Niederer.

The Examiner cites Niederer for teaching the claimed fins. However, the portion of Niederer on which the Examiner relies for this teaching, the collar-like projection 12 in FIGS. 103, provides no disclosure of fins that project from a face of a shaft. Rather, collar-like projection 12 is merely a transition from the thin and narrow shank 2 to the thicker neck 6 of the prosthesis of Niederer. See Niederer, col. 2, lines 66-68. Collar-like projection 12 is not a fin that projects from the face of shank 2 as required by the claims. The width of collar-like projection 12 does not increase as required by the claims. Collar-like projection 12 does not have a surface portion

delimited by a medial edge and a lateral edge, with the medial edge forming a borderline between the surface portion and a steep flank, as required by the claims.

Accordingly, because Niederer does not disclose the elements required by the claims, the rejection of claim 1 and claims depending thereon should be withdrawn. Further, the deficiencies of Niederer are not compensated for by Tanamal for the reasons described above.

Further, in the second paragraph of page 4 of the Action, the Examiner concedes that neither reference discloses a significant aspect of the claimed invention, that the claimed fins “extend rectilinearly at an angle of 5 to 15° with respect to the longitudinal axis of the shaft.” The Examiner contends that persons of ordinary skill in the art would have extended the fins in this manner as “an obvious matter of design choices.” The salient question here is: “Why?” The Examiner has not explained *why* any person of ordinary skill in the art would have considered the claimed fin extension configuration to be a viable design choice *at all*, let alone an “obvious” design choice. There is no prior art or other competent evidence that any person of ordinary skill in the art would have seen that extending the fins rectilinearly at an angle of 5 to 15° relative to the longitudinal axis of the shaft was “a mere change in size of a component,” as alleged by the Examiner.

Under the *KSR* Guidelines issued by the PTO, the Examiner must make fact findings based on evidence and reasoning, not simply speculate as to matters of obvious design choice without evidentiary support. As explained at 72 Fed. Reg. 57527:

In short, the focus when making a determination of obviousness should be on what a person of ordinary skill in the pertinent art would have known at the time of the invention, and on what such a person would have reasonably been expected to be able to do in view of that knowledge.

This does not relieve the Examiner of the duty to explain *why* the invention would have been obvious in light of the prior art. *Id.* at 57528. The Examiner’s finding of obvious design choice is

based on classic hindsight, as there is nothing in the record as to any reason why a person of ordinary skill in the art, not knowing of Applicant's invention, would even have considered the alleged obvious choice constructed by the Examiner. To use, the words of the guidelines, there is no evidence that the claimed fin extension configuration is "what such a person would have *reasonably* been expected to be able to do in view of [the prior art] knowledge." [Emphasis added.]

In view of the above, early action allowing claims 1-8 is solicited.

In the event the U.S. Patent and Trademark Office determines that an extension and/or other relief is required, Applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. **03-1952** referencing docket no. **246472007600**.

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